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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/753,240

01/08/2004

William Gerrie

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08/15/2006

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3636

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/753,240	Applicant(s) GERRIE ET AL.	
	Examiner Tamara L. Graysay	Art Unit 3636	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5,7-9,11-13 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5,7-9,11-13,18 and 19 is/are allowed.
- 6) ☒ Claim(s) 20-21 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election of Species A: FIGS. 1-5 in the reply filed on 14 June 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claim 23 is allowable. The restriction requirement between species A and species B, as set forth in the Office action mailed on 08 March 2006, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claim 22, directed to species B remains withdrawn from further consideration because it does not require all the limitations of an allowable generic linking claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim(s) presented in a continuation or divisional application include all the limitations of a claim that is allowable in the present application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Drawings*

4. The drawings were received on 14 June 2006. These drawings are objectionable.
5. The drawings are objected to because of the following:
  - a. FIGS. 2A and 6A should not be encircled.
  - b. They fail to comply with 37 CFR 1.84(l) because every line (ALL FIGS) is not sufficiently dense and dark, and *uniformly thick and well-defined*.
  - c. They fail to comply with 37 CFR 1.84(p)(1) because the reference characters are not *plain* and legible.
  - d. See the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948 (Attachment 2).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

6. Claims 20-21 and 23 are objected to because of the following informalities:

Claims 20-21: The preamble recites the cover in combination with the golf cart, however, the body of the claim still positively recites the golf clubs (e.g., providing access to golf clubs in the bag). The claims have been treated as a subcombination drawn to the golf cart and cover, not including the golf clubs. That is to say, *adapted to provide access to* golf clubs in the bag.

Claim 23, line 5: [[golf cart roofs]] should be golf cart roof so.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (US-6481780) in view of Chapman (US-5146967).

Claim 20: Dolan discloses a rigid frame (255, 270; FIG. 2A) connected to a golf cart (200) at the rear thereof, the frame extending rearward and downward (252) sized to encompass at least an upper end of a golf bag (237) carried on the cart (200) and the aft

end portion extending from the rear roof line (uppermost end of frame member 252, 270) to overlie an upper portion of the golf bag (FIG. 2A); and, a flexible canopy (260) carried by the frame and movable relative to the frame (material 260 may be detached from the frame and rolled toward the rear frame 240; 4:57-62) between a stowed position (rolled toward the rear frame) and deployed position (as depicted in FIG. 2A), the canopy disposed along the aft end (FIG. 2A) and adapted to protectively overlie the golf bag.

Dolan lacks the closable opening adapted to align with the golf bag when the canopy is deployed and adapted to provide access to golf clubs in the bag.

Chapman teaches a cover having at least one closable opening (access orifice 4) adapted to align with an upper end of a golf bag when the canopy is deployed (FIG. 1) to allow access to the golf clubs when the canopy is in the deployed position and without removing the canopy.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the canopy of Dolan to include at least one closable opening such as suggested by Chapman, in order to access the golf clubs when the canopy is in a deployed position.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (US-6481780) and Chapman (US-5146967) as applied to claim 20, respectively, above, and further in view of Veilleux (US-3146824).

Claim 21: The Dolan canopy, as modified by Chapman, is in the field of framed covers.

Veilleux, also in the field of framed covers, teaches a canopy (10) and a housing (4). The

canopy, when stowed, is at least partly disposed in a roll in the housing (e.g., FIG. 2).

The canopy is biased toward the stowed position (3:39-47). Such an arrangement provides a compact storage area for the canopy when stowed and provides an easy deployment of the canopy from the roll within the housing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the frame of Dolan and Chapman to include a housing, such as suggested by Veilleux, in order to provide a compact storage area for the canopy when stowed and provide an easy deployment of the canopy from the roll within the housing.

#### ***Response to Arguments***

9. Applicant's arguments filed 14 June 2006 have been fully considered but they are not persuasive as to claims 20 and 21.

Claim 20: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Further, applicant argues that Dolan teaches away from modification in light of Chapman because Dolan accommodates better access to the golf clubs on the cart by providing additional or curved members.

In this case, the knowledge generally available to one of ordinary skill in the art of covers would have recognized, having both the Dolan and Chapman references that providing at least one opening in the Dolan canopy, as suggested by the Chapman

openings that inherently provide access to golf clubs on a golf cart without retracting or moving the cover, would similarly provide access the golf clubs when the Dolan canopy is in a deployed position. Moreover, as explicitly mentioned in Dolan, improved access to the covered golf clubs on a golf cart is a consideration (5:26-31) that would provide for modification of the Dolan device. The motivation in Dolan and suggestion in Chapman together with the motivation based on knowledge generally available to one of ordinary skill in the art establishes the *prima facie* case of obviousness set forth in the above rejection of claim 20.

Claim 21: While applicant mentions the rejection of claim 21 on page 14 of the response, applicant has not separately argued the features of claim 21, i.e., the housing and roll.

*Allowable Subject Matter*

10. Claims 23, 3-5, 7-9, 11-13, 18 and 19 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter:

Claim 23: Applicant's arguments at page 15 of the response as to the failure to establish a *prima facie* case of obviousness for modification of Dolan in view of Dean (in as much as the combination is applicable to claim 23) are deemed persuasive insofar as there is no motivation or suggestion in Dolan or Dean to add to Dolan two upright pieces, each connected at one end to a horizontal piece and at the other end to a curved piece. Dolan is explicit as to the connection of the frame to the seat, not the roof.

Further, considering Dean as the primary reference because the claim is limited to the subcombination of the cover, there is no suggestion to modify Dean to include a pair of closable openings in a particular location because Dean is used to provide cover for an open window on a building. There would be no motivation to provide a pair of closable openings in the cover.



***Conclusion***

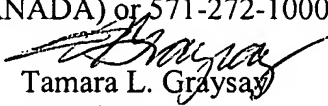
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Tamara L. Graysay  
Examiner  
Art Unit 3636